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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,641	12/17/2003	Don T. Cameron	20003.0075	3833
7590	01/31/2008		EXAMINER	
Edward A. Pennington, Esq. Swidler Berlin Shreff Friedman, LLP Suite 300 3000 K Street, N.W. Washington, DC 20007-5116			MCCORMICK, GABRIELLE A	
		ART UNIT	PAPER NUMBER	
		3629		
			MAIL DATE	DELIVERY MODE
			01/31/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,641	CAMERON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gabrielle McCormick	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 December 2003.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>12/17/2003</u> .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Status of Claims***

1. This action is in reply to the application filed on December 17, 2003.
2. Claims 1-27 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The Information Disclosure Statement filed on December 17, 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The term "substantially" in claim 1 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Page 5, line 19 of the specification discloses that a "determination is then made whether the features substantially conform to the manufacturing specifications." Discussion follows regarding deviations due to normal use of the product. It is unclear whether if the determination that the product does not substantially conform whether this could be due to abnormal use, extreme use or that the product's features do not match some or all of the manufacturing specifications. Further, the definition of "normal" use, were it to be incorporated into the claim language, would similarly raise questions of clarity, as it too is a relative term. Claims 2-27 are rejected based on their dependency from claim 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-10, 13, 15-16, 18-19 and 23-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>;  
<http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>;  
<http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>;  
<http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>).

9. **Claims 1-7, 13, 15, 19 and 27:** Callaway discloses a method where used Callaway golf clubs can be traded in for either new or previously owned clubs. The method involves mailing the club for trade to Callaway (pg. 1; III), verifying the club (pg. 1; VI) and returning an unacceptable club (pg. 2; bullets 5&6). Clubs that are accepted are given a “Certified Preowned title” (i.e., results are reported) after passing a “meticulous inspection.” It is obvious that as the manufacturer of the preowned clubs, Callaway would have access to manufacturing specifications and would therefore determine whether the features of the traded clubs conform to the manufacturing specifications. It is inherent that as the manufacturer, Callaway is an authorized authenticator. On pages 4 and 5, Callaway discloses features of a certified preowned club, including physical dimensions (loft), materials (graphite), manufacturer markings (“Callaway” in the photo), shape (driver), stamping (see bottom of club in photo), shaft (Callaway BBUL Graphite) and condition (fair). Callaway provides definitions for grading the condition of preowned clubs based on the

number of rounds of golf played. (pg. 6). These results are available through a website link. (pg. 4).

10. Callaway does not disclose the *finish, paint fill grip or weight*.
11. However, these differences are only found in the **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The identification of relevant features would be performed regardless of specific features such as finish, paint fill, grip and weight.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included finish, paint fill, grip and weight because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of relevant features does not patentably distinguish the claimed invention. It is obvious that in Callaway's disclosure of additional features such as gender, lie angle, hand and flex that the relevant features that Callaway deems necessary to aiding in the sale of certified preowned clubs is provided and that should additional information be necessary, Callaway would be capable of providing it.
13. **Claims 8-10:** Callaway receives the club and performs a "meticulous inspection" as part of the certification process. (pg. 3). Though Callaway does not disclose a first, second or third view, it is inherent that the club is viewed numerous times and from numerous angles during the inspection. Further, the photo of the certified club (pg. 4) discloses a view of a *distinguishing mark on the equipment* ("Callaway WAR BIRD").
14. **Claims 16 and 18:** Callaway discloses a "Certified Preowned title" (pg. 3). The word "Callaway" on the pictured "Certificate of Authenticity" is a seal. It cannot be determined whether "Callaway" is embossed. Further, a picture or a reference number is not disclosed with the Certificate,

however, on page 4, a photo and a SKU # are provided for a club offered for sale as a certified preowned club.

15. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included the photo and SKU with the certificate for the motivation of providing increased assurance to the purchaser of the club that the club is traceable to the certificate. It is old and well known to provide details linking a physical product to a document that certifies its characteristics for quality assurance and traceability purposes. Embossing the word "Callaway" would be an obvious addition to the certificate as a means of preventing forged copies of the certificate.
16. **Claims 23-26:** Callaway discloses a mailing label (pg. 1; V). The mailing label would be created through an automated process when it is printed using standard print commands that inherently reside on an Internet browser. Callaway is notified of the request in step V: "Mail a copy of the Trade in Form along with the club to be traded". Furthermore, it is obvious that the Trade in Form would also serve as a packing slip as it would provide a description of the club to be traded in.
17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included using the Trade in Form as a packing slip for the motivation of providing a method of providing a paper trail to verify that the correct item was mailed.
18. **Claims 11-12, 14 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>; <http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; <http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Chester (US Pub. No. 2004/0054888).

19. **Claims 11 and 12:** Callaway discloses the method of claim 1. Callaway does not disclose *comparing the equipment to a previously prepared record of the equipment.*
20. Chester, however, discloses “verifying the authenticity and ownership of a registered item or article by querying the accrediting authority”, transferring an item, issuing a new certification of authenticity to new purchaser and registering the transferred item or article and new owner. (P[0016]). During verification and title transfer, the correct owner and “a static digital image” (i.e., picture) is provided. (P[0032]). Thus, Chester provides access to a previous record and a picture.
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included comparison to previous records and pictures, as disclosed by Chester, in the system of Callaway for the motivation of verifying ownership at the time of trade-in. Callaway would be motivated to access previous records and photos to ensure that a club received had not been stolen from a registered owner. It is old and well known that companies track the ownership of products sold for various purposes, including offering new product promotions.
22. **Claims 14 and 17:** Callaway discloses the methods of claims 1 and 16. Callaway does not disclose *making an indicia or providing said reference number on the equipment.*
23. Chester, however, discloses a “hologram with embedded attributes with encrypted protection and password or personal identification number...for use with each separate item or article to be authenticated by each authorized distributor...” (P[0029]).
24. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included indicia and reference number on an authenticated item, as disclosed by Chester, in the system of Callaway for the motivation of linking the item to a certificate of authentication.
25. **Claims 20-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>;

<http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>;  
<http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Greenwichgolf.com ((pages documented from the Internet Archive at <http://web.archive.org/web/20020605164840/greenwichgolf.com/ser02.htm>).

26. **Claims 20-21:** Callaway discloses the method of claim 1, however, Callaway does not disclose altering the equipment from its original condition.
27. Greenwichgolf.com discloses offering alterations to golf equipment.
28. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included altering equipment, as disclosed by Greenwichgolf.com, in the system of Callaway for the motivation of making lies right for a person's swing. (Greenwichgolf.com).
29. It is would have been obvious to one of ordinary skill in the art at the time of the invention to have included reporting how the equipment was altered. Callaway discloses on pages 4 and 5 "Lie Angle: Standard" and "Length: Standard". It would have been obvious that had the club been altered from "Standard", that it would have been reported.
30. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway (pages documented from the Internet Archive from November 29, 2002 at <http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>; <http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>; <http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; <http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>) in view of Harrel ("Scrutinizing the numbers". InfoWorld. San Mateo: Aug. 19, 2002. Vol 24, Iss. 33; pg. 35).
31. **Claim 22:** Callaway discloses the method of claim 1. Callaway does not disclose a color-coded certificate based on results.

32. Harreld, however, discloses the executive receive color-coded reports highlighting any variances from performance goals. (pg. 2; para. 12).
33. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included color coding certificates based on results, as disclosed by Harreld, in the system of Callaway for the motivation of providing a visual alert. For example, if a club was listed as Condition: Very Good, color-coding would provide a visual clue that would direct potential buyers to that listing and therefore increase the likelihood of selling the club.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is 571-270-1828. The examiner can normally be reached on Monday - Thursday (6:00- 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

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/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629